

**Court of Appeals, Federal Circuit**

In re Gulack

No. 82-580

Decided Mar. 30, 1983

**PATENTS**

**1. Patentability — Anticipation — In general (§51.201)**

**Patentability — Invention — In general (§51.501)**

**Patentability — Subject matter for patent monopoly — Printed matter (§51.611)**

Differences between invention and prior art cited against it cannot be ignored merely because those differences reside in content of printed matter; "printed matter rejection" under Section 103 stands on questionable legal and logical footing; standing alone, description of element of invention as printed matter tells nothing about differences between invention and prior art or about whether that invention was suggested by prior art; printed matter rejection is based on case law anachronizing 1952 Patent Act, employing point of novelty approach; 1952 Act legislatively revised that approach through its requirement that claim be viewed as whole in determining obviousness, under Section 103; Board of Appeals cannot dissect claim, excise printed matter from it, and declare remaining portion of mutilated claim to be unpatentable; claim must read as whole.

**2. Patentability — Anticipation — In general (§51.201)**

**Patentability — Invention — In general (§51.501)**

**Patentability — Subject matter for patent monopoly — Printed matter (§51.611)**

Printed matter that is not functionally related to substrate does not distinguish invention from prior art in terms of patentability; although printed matter must be considered, in that situation it may not be entitled to patentable weight.

**3. Patentability — Anticipation — In general (§51.201)**

**Patentability — Invention — In general (§51.501)**

**Patentability — Subject matter for patent monopoly — Printed matter (§51.611)**

Functional relationship between printed matter and substrate of precise type found in *In re Miller*, 164 USPQ 46, — to size or type of substrate, or conveying information about substrate — is not required; what is required is existence of differences between appealed claims and prior art sufficient to establish patentability; bare presence or absence of specific functional relationship, without further analysis, is not dispositive of obviousness; rather, critical question is whether there exists any new and unobvious functional relationship between printed matter and substrate.

**Particular patents — Mathematical Device**

Gulack, Educational and Recreational Mathematical Device in the Form of a Band, Ring or Concentric Rings, rejection of claims 1-4 and 6 reversed.

**Appeal from Patent and Trademark Office Board of Appeals.**

Application for patent of Max A. Gulack, Serial No. 935,183, filed Aug. 18, 1978. From decision rejecting claims 1-4 and 6, applicant appeals. Reversed. Friedman, Circuit Judge, dissenting with opinion.

C. Bruce Hanburg, New York, N.Y., for appellant.

John W. Dewhurst (Joseph F. Nakamura and Fred E. McKevey, on the brief) for U.S. Patent and Trademark Office.

Before Friedman, Baldwin, and Smith, Circuit Judges.

Smith, Circuit Judge.

This is an appeal from the decision of the U.S. Patent and Trademark Office Board of Appeals sustaining the rejection under 35 U.S.C. §103 of claims 1-4 and 6 of application serial No. 93,183, filed August 18, 1978, entitled "Educational and Recreational Mathematical Device in the Form of a Band, Ring or Concentric Rings." We reverse.

**I.**

The stated object of the disclosed invention is to exploit certain arithmetic properties of all prime numbers larger than 5,  $P^1$  to create the semblance of magic or to educate

<sup>1</sup> The variable  $P$  is defined in the specification as any prime number (an integer not divisible without remainder by any number except itself and unity) greater than 5. E.g., 7, 11, 13, etc.



basic principle of claim interpretation, we must reverse the rejection as a matter of law.

[2] If, instead, the board sought only to construe and apply Miller within the context of a section 103 rejection, we find no error in the board's articulation of the law. Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.<sup>10</sup> Although the printed matter must be considered, in that situation it may not be entitled to patentable weight. This, apparently, was the board's conclusion with respect to Gulack's invention.

However, because we find that the digits of Gulack's invention are functionally related to the band, and because Witcoff fails to disclose or suggest the subject matter recited in the appealed claims, considered as a whole, we reverse.

The sole issue is whether the board correctly affirmed the rejection of the appealed claims as obvious in view of Witcoff under 35 U.S.C. §103.

## II.

The board, responding to appellant's arguments based on *In re Miller*,<sup>11</sup> found no functional relationship of the type present in *Miller*.

## A.

Miller involved an appeal from the board's affirmation of the rejection of claims drawn to a measuring device for use in fractionating recipes. No statutory ground for the rejection was specified. The rejection in Miller was on the basis that the invention lacked "the required cooperative structural relationship necessary before the printed matter can be given patentable weight."<sup>12</sup>

The CCPA<sup>13</sup> responded, stating:<sup>14</sup>

[I]t seems to us that what is significant here is not structural but *functional* relationship \*\*\*.

As for the examiner's characterization of the *indicia* and *legend* as "unpatentable printed matter," we note that the examiner

himself recognizes the fact that printed matter, in an article of manufacture claim, can be given "patentable weight." He did so in allowing claims. His characterization of printed matter as "unpatentable" is beside the point; no attempt is here being made to patent printed matter *by itself* is not

patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination. Here there is a new and unobvious functional relationship between a measuring *receptacle*, volumetric *indicia* thereon indicating volume in a certain ratio to actual volume, and a *legend* indicating the ratio, and in our judgment the appealed claims properly define this relationship. \*\*\*

[Emphasis in original.]

The court found that the printed matter of Miller's invention was functionally related to the volume measuring device and reversed the rejection.

## B.

[3] Similarly, in examining Gulack's invention, we find that a functional relationship does exist between the printed matter and the substrate. A functional relationship of the precise type found by the CCPA in *Miller*—to size or to type of substrate, or conveying information about substrate—is not required. What is required is the existence of *differences* between the appealed claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.<sup>15</sup> With these thoughts in mind we turn now to examine the obviousness of the appealed claims in light of the cited reference, Witcoff.

## III.

Appellant and the board agree that the sole difference between the appealed claims and Witcoff resides in the content of the printed matter. The board declined, however, to accord that printed matter patentable weight.

Witcoff discloses the application of printed matter to a band. The printed matter suggested by Witcoff is data that is to be committed to memory, such as addition, subtraction,

multiplication, history dates, historical performances, and the like. The data items are independent, bearing no direct relation to the other data entries on Witcoff's band. The relationship of the Witcoff data to the band is for purposes of support and display. The data must be imprinted on the band so that the answer to the inquiry displayed on the outer surface of the band is visible when viewed from inside the hat through the aperture. Witcoff discloses an endless band, yet the areas of printed matter displayed on the Witcoff band are not arranged in any particular sequence.

The appealed claims, on the other hand, require a particular sequence of digits to be displayed on the outside surface of a band. These digits are related to the band in two ways: (1) the band supports the digits; and (2) there is an endless sequence of digits—each digit residing in a unique position with respect to every other digit in an endless loop. Thus, the digits exploit the endless nature of the band.

The differences between the appealed claims and Witcoff reside in appellant's particular sequence of digits Q, and in the derivation of that sequence of digits. These features are critical to the invention disclosed by the appealed claims. Witcoff neither discloses nor suggests either feature.

## IV.

We reject the board's conclusion that there is no functional relationship between the printed matter and the substrate of the appealed claims. Such a relationship does exist and it is different from the relationship exhibited by the corresponding elements of the Witcoff reference. We find no suggestion in the cited reference of appellant's particular sequence of digits Q or of the derivation of that sequence.

*Reversed.*

Friedman, Circuit Judge, dissenting.

I would affirm the Board's decision sustaining the rejection of the claimed invention as obvious under section 103.

The appellant's primary claim is for "[a]n educational and recreational mathematical device," namely, an endless band upon which are imprinted numbers in a particular sequence derived from the application of an algorithm. Subordinate claims describe the band as an article of apparel, part of a hat or cap, or an article of jewelry.

The algorithm is not patentable and "is treated as though it were a familiar part of

the prior art." *Parker v. Flook*, 437 U.S. 584, 592 (1978). Similarly, the particular numbers produced by an abstract solution of the algorithm cannot themselves be claimed, although the practical application of those numbers may be patentable. See *In re Meyer*, 688 F.2d 789, 215 USPQ 193 (CCPA 1982); *In re Abele*, 684 F.2d 902, 214 USPQ 682 (CCPA 1982). The issue under section 103 is whether, to one of ordinary skill in the art of developing algorithms and applying their product for educational or recreational purposes, it would have been obvious to apply the algorithm by displaying the result of its solution on a continuous band, as the appellant disclosed in his patent application. The Board correctly answered that question affirmatively.

The Witcoff patent teaches the use of a band to display numbers as an "educational or game-playing device." Although there are differences between the display of numbers in appellant's invention and their display in Witcoff, it would have been obvious from Witcoff for one of ordinary skill in the art who wanted to use the numbers the algorithm produced for appellant's purposes, to display them on a continuous band. Indeed, one of the appellant's subordinate claims displays the numbers on a hat or cap.

The display of the numbers on a band or other object that permits them to be shown in a series without a particular beginning or end would have been obvious even without Witcoff. The numbers can be used for the recreational and educational purposes the appellant claims merely by arranging them in a continuous series. They do not need to be placed on an "endless band" as the appellant claimed. In fact, at oral argument the appellant conceded that the same result his invention accomplishes also could be accomplished by placing the numbers in a continuous series upon a cube or other shape, or even by writing them in a circle upon a flat surface. The precise nature of the object on which the numbers are placed is thus of little importance—the arrangement of the numbers as a continuous series—would have been obvious to anyone of ordinary skill in the art who knew the algorithm.

In *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969), as the court points out, the court determined that there was "a new and unobvious functional relationship" between the measuring receptacles and the descriptions and legends on them. In the present case, unlike *Miller*, I do not think that the "functional relationship" between the num-

<sup>10</sup> *Miller*, 418 F.2d 1392, 164 USPQ 46.

<sup>11</sup> *Id.*

<sup>12</sup> *Id.* at 1395, 164 USPQ at 48.

<sup>13</sup> The holdings of the United States Court of Customs and Patent Appeals and of the United States Court of Claims were adopted as precedent in the Court of Appeals for the Federal Circuit in *South Corp. v. United States*, 690 F.2d 1368, 1370, 215 USPQ 657, 658 (Fed. Cir. 1982).

<sup>14</sup> *Miller*, 418 F.2d at 1396, 164 USPQ at 48-49.

<sup>15</sup> *Id.* at 1396, 164 USPQ at 49.



algorithm and their display upon the continuous band was new and unobvious.

### Court of Appeals, Ninth Circuit

Jason v. Fonda, et al.

No. 81-5973

Decided Feb. 8, 1983

### COPYRIGHTS

#### 1. Infringement — Evidence of (§24.05)

Evidence showing no more than "bare possibility" that alleged infringers had access to author's work is insufficient to create issue of material fact.

#### 2. Infringement — Evidence of (§24.205)

Even assuming alleged infringers had access to author's work, infringement is not established if there is no substantial similarity between two works.

#### 3. Pleading and practice in courts — Dismissal of suit (§53.33)

It is proper to dismiss pendent state claims when federal claim is dismissed prior to trial.

Appeal from District Court for Central District of California, Kelleher, J.; 217 USPQ 231.

Action by Sonya Jason, against Jane Fonda, Bruce Gilbert, Jerome Hellman, JPL Production, Inc., United Artists Corporation, National Broadcasting Company, Inc., Nancy Dowd, Robert C. Jones, and Waldo Salt, for copyright infringement, unfair competition, misappropriation, and breach of implied contract. From order granting summary judgment for defendants, plaintiff appeals. Affirmed.

Ronald S. Rosen, Los Angeles, Calif., for defendants.

Before Anderson, Pregerson, and Nelson, Circuit Judges.

Anderson, Circuit Judge.

Sonya Jason brought an action against Jane Fonda and eight other defendants for copyright infringement, unfair competition, misappropriation, and breach of implied contract. Mrs. Jason's primary allegation was that the defendants' motion picture, *Coming Home*, infringed on the copyright in her novel, *Concomitant Soldier — Woman and War*. The district court granted the defendants' motion for summary judgment and dismissed the other claims. We affirm.

[1,2,3] Our review of the facts and issues leads us to concur in the well-reasoned decision of Judge Kelleher filed September 21, 1981, 526 F.Supp. 774, 217 USPQ 231 (C.D. Cal. 1982). We therefore incorporate his memorandum of decision by reference. Judge Kelleher aptly points out:

(1) Mrs. Jason presented evidence showing no more than a "bare possibility" that the defendants has access to her work. Such a showing is insufficient to create a genuine issue of material fact. See *British Airways Board v. Boeing Company*, 585 F.2d 946, 952 (9th Cir. 1978), cert. denied, 440 U.S. 981 (1979);

(2) Even assuming access, there was no substantial similarity between the two works under the standards announced by this court in *Sid & Marty Kroff Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 196 USPQ 97 (9th Cir. 1977); and

(3) It is proper to dismiss pendent state claims when the federal claim is dismissed prior to trial. *Wham-O Mfg. Co. v. Paradise Manufacturing Co.*, 327 F.2d 748, 753, 140 USPQ 357, 361-362 (9th Cir. 1964); see also, *Wren v. Sletten Construction Co.*, 654 F.2d 529, 536 (9th Cir. 1981).

Additionally, Judge Kelleher did not abuse his discretion in handling discovery nor in denying Mrs. Jason's motion for reconsideration.

The appellees' request for sanctions and attorney's fees is denied. Single costs are allowed.

The judgment of the district court is affirmed.

### Court of Appeals, Ninth Circuit

Cher

v. Forum International, Ltd. et al.

Nos. 82-5106 and 82-5107

Decided Nov. 18, 1982

### UNFAIR COMPETITION

#### 1. Miscellaneous cases (§68.65)

Magazine's publication of interview with public figure is protected by First Amendment; this protection extends to magazine's use of headlines and cover display, so long as headlines and promotional devices were true or were not published with knowledge that they were false or in reckless disregard for their truth.

#### 2. Miscellaneous cases (§68.65)

California law permits recovery for unauthorized use of one's likeness or name for commercial purposes; however, no action under this theory will lie solely for publication which is protected by First Amendment.

#### 3. Miscellaneous cases (§68.65)

Constitutional protection extends to truthful use of public figure's name and likeness in advertising which is merely adjunct of protected publication and promotes only protected publication.

#### 4. Miscellaneous cases (§68.65)

Advertising to promote news medium is not actionable under appropriation of publicity theory so long as advertising does not falsely claim that public figure endorses that news medium.

#### 5. Miscellaneous cases (§68.65)

Magazine is entitled to use public figure's picture and to refer to her truthfully in subscription advertising for purpose of indicating content of publication in which she was interviewed; such usage is protected by First Amendment.

#### 6. Miscellaneous cases (§68.65)

Magazine that falsely claims in its advertisements that celebrity told it things, she would never tell rival magazine, when in fact she had intended to give interview to rival magazine, and had not told anything to magazine that published it, is not protected by First Amendment.

#### 7. Miscellaneous cases (§68.65)

First Amendment does not protect magazine that published, with knowledge that they were false or in reckless disregard for their

truth, advertisements which implied that celebrity endorsed magazine; therefore, magazine is liable to celebrity for wrongfully appropriating her right of publicity.

#### 8. Accounting — Parties liable (§11.45)

#### Miscellaneous cases (§68.65)

Company that owns 80% of stock of magazine, and that participated in preparation of advertisements which appeared in magazine, participated sufficiently in false advertising to share magazine's liability to public figure whose celebrity value was exploited by the advertisements.

#### 9. Accounting — Damages — Trademark and unfair competition (§11.256)

Magazine that wrongfully appropriated celebrity's right of publicity by using false advertising and promotional misrepresentation that exploited celebrity's publicity value liable to celebrity for general, special, and exemplary damages.

Appeal from District Court for Central District of California; Real, J., 213 USPQ 96.

Action by Cher, against Forum International, Ltd., doing business as Forum Magazine, Penthouse International, Ltd., New Group Publications, Inc., doing business as the Star, and Fred Robbins, for breach of contract, unfair competition, misappropriation of name and likeness, misappropriation of right to publicity, and violations of Lanham Act. From order granting judgment for plaintiff, defendants appeal. Affirmed in part, modified in part, and reversed in part.

John D. Forbess, and Rubin, Perstein & Chieffo, both of Beverly Hills, Calif., for plaintiff.

Douglas C. Conroy, and Paul, Hastings, Jaroffsky & Walker, both of Los Angeles, Calif., and Roy Grutman, and Grutman & Miller, both of New York, N.Y., for Forum International Ltd. and Fred Robbins

Louis P. Petrich, and Youngman, Hungate & Leopold, both of Los Angeles, Calif., for Penthouse International Ltd.